REMARKS

This Amendment and Response is being submitted in response to the Office Action dated January 9, 2004. In the Office Action, claims 1, 7-12, 14, 18 and 20-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,535 issued to Pham et al. ("Pham") in view of U.S. Patent No. 6,224,387 issued to Jones ("Jones"). Claims 2-6, 13, 15-17, 19 and 24 were similarly rejected under 35 U.S.C. 103(a) over Pham, Jones and additional cited references. Claim 24 is being cancelled, with claims 1-23 pending. Reexamination and reconsideration in light of the amendment and remarks made herein are respectfully requested.

As discussed on p. 2 of the present application, documents which are digitally signed may look different when the recipient receives them. One aspect of the disclosure is directed to a method and apparatus which "establishes integrity and trust in the digital signatures, providing evidence that the sending and receiving parties are seeing the identical view of the digitally signed document(s)." See Application, p. 5, lines 4-6.

Pham, on the other hand, is simply directed to transmitting data files that are compatible to one system over a network in a way that such data files are compatible with other types of system. In Pham, native files are encoded as simple text files for accessing on any system, while still retaining the attributes of the originating system. See Pham, Col. 3, line 64 to Col. 4, line 2. While Pham does mention digitally signing the "container" of data files, this is simply a

traditional public/private key encryption operation which is unconcerned with the visual integrity of the data. See Pham, Col. 4, lines 3-9.

Applicant submits that Pham fails to teach or disclose the arrangement of the present claims. In particular, Pham does not teach or disclose "applying the predetermined format and viewer program to a hash function . . . to provide a message digest," as recited in claim 1. In Pham, the "container" is what is digitally signed, whereas in this aspect of the present invention the product of the hash function (i.e., the message digest) is what is encrypted "using a private key to provide a digital signature," again as recited in claim 1.

Moreover, Applicant submits that Pham fails to disclose or suggest a "viewer program," as that term is used in the present disclosure. While the examiner agrees with this much, the Applicant further believes that Pham actually teaches away from the use of a viewer program since the native files in Pham are encoded as simple text files for accessing on any system – thereby eliminating any need for a specific viewer program. The fact that Pham fails to disclose a viewer program is expected, however, since Pham is not concerned with avoiding the visual corruption of the document the way the present disclosure is. In fact, Pham intends to visually corrupt the document since it purposefully converts it to standard text format, thereby intentionally stripping out much of the formatting.

Applicant also submits that Jones is non-analogous art. As stated in MPEP §2141.01(a), "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." (citing *In re Oetiker*, 977 F.2d, 1443, 1446 (Fed. Cir. 1992)). To that end, and as will be described below, Jones is neither in the field of this aspect of the present invention, nor are either of the cited references directed to the same problem as this aspect of the present invention.

Any reasonable reading of Jones would find that it bears no correlation to the present invention. Jones is directed to a process for providing an online pictorial tour. Jones is oblivious to issues of data integrity and security. In fact, a careful review of Jones indicates that it doesn't even once use the term encryption, digest, signature, hash, public key or private key.

Moreover, Applicant submits that neither Jones nor Pham are directed to the problem of the present invention. As discussed above, Pham actually does the opposite as this aspect of the present invention (i.e., strips document formatting instead of preserving it), and Jones fails to even once mention the issue of data integrity. One skilled in the art would not view Pham and Jones as analogous art, and as such, Applicant submits that combination of these references is inappropriate in the present context.

Even if Jones can be viewed as analogous art, which Applicant vehemently denies, Applicant submits that it does not teach or suggest using a "viewer program" as it is used in the present disclosure. While Jones once mentions a "plug-in viewer," the fact of the matter is that plug-in viewers are commonly known in the art and any number of references can most likely be found that mention this type of software. However, the viewer program of this aspect of the present disclosure is subjected to a hash function and digital signature operation along with the predetermined format, as recited in the claims.
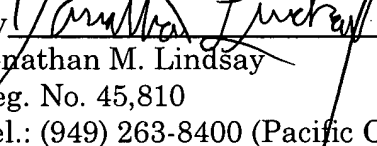
Even if Pham discloses subjected a converted document file to a hash function and digital signature operation (which it does not for the reasons as discussed above), and even if Jones separately discloses a viewer program, there is still no teaching or suggestion of a viewer program that is subjected to a hash function and digital signature operation, as recited in the present claims. In other words, the disclosure of performing a hash function and digital signature operation on a converted document, and the separate disclosure of a viewer program, in combination is not tantamount to disclosing performing a hash function and digital signature operation on the viewer program. Applicant submits that this is a non-trivial distinction since the inclusion of the viewer program in the hashing and digital signing process enables the documents visual integrity to be maintained, while also maintaining the document data's security against would be hackers.

Applicant respectfully submits that the application is now in condition for allowance. Applicant further submits that the dependent claims are allowable by virtue of depending on allowable base claims. If there are any questions regarding this Response or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Respectfully submitted,

CROWELL & MORING LLP

Dated: May 7, 2004

By_____
Jonathan M. Lindsay
Reg. No. 45,810
Tel.: (949) 263-8400 (Pacific Coast)

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

■ *deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.*

FACSIMILE

☐ *transmitted by facsimile to the Patent and Trademark Office.*

05/_7_/2004

_____
Angela Williams   *Date*